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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,887	11/22/2006	Bahaa Botros Seedhom	7881.15	2241
21999 7590 03/16/2010 KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111				
EXAMINER WAGGLE, JR, LARRY E				
ART UNIT		PAPER NUMBER		
3775				
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03/16/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/577,887

Applicant(s)

SEEDHOM ET AL.

Examiner

Larry E. Waggle, Jr

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7, 9-10 and 14-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 9-10 and 14-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 29, as shown in Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 7, 10 and 14-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Scarborough et al. (US Patent 5928238) in view of Spranza, III (US Patent 6884245).

Scarborough et al. disclose a bone site preparation device (Figure 19) comprising a reamer (40) having cutting teeth at one end and being coupled to a power tool (20) at the other end; a centralizing device (322, 330, 332 and 44) housed within the reamer and having a pointed end (44); and means (330) biasing the pointed end axially outwardly of the reamer to engage with the bone whereby a surgeon may operate the device via one hand by simultaneously maintaining the centralizing device

engaged with the bone while cutting the annular groove with the reamer (Figures 7 and 19-23 and column 6, line 40 – column 7, line 47).

Scarborough et al. disclose the claimed invention except for a debris channel formed at one end of the reamer to allow bone fragments formed by the teeth to escape while the annular groove is being formed. Spranza, III teach a reamer (Figure 2) comprising cutting teeth (14) and debris channels (15) aligned parallel with the longitudinal axis of the reamer (column 3, lines 38-50). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Scarborough et al. with the reamer comprising cutting teeth (14) and debris channels aligned parallel with the longitudinal axis of the reamer in view of Spranza, III in order to facilitate clearing the bone chip fragment formed by the cutting teeth from the groove.

Scarborough et al. in view of Spranza, III disclose the claimed invention except for the length by which the channel extends over the length of the reamer from the cutting edge is greater than the length by which the teeth extend along the length of the reamer from the cutting edge; the length by which the channel extends from the cutting edge is greater than the width or diameter of the reamer; and the length by which the channel extends along the longitudinal axis is greater than the width of the channel. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Scarborough et al. in view of Spranza, III with the length by which the channel extends over the length of the reamer from the cutting edge is greater than the length by which the teeth extend along the length of the reamer from

the cutting edge; the length by which the channel extends from the cutting edge is greater than the width or diameter of the reamer; and the length by which the channel extends along the longitudinal axis is greater than the width of the channel in order to facilitate a more efficient clearing of bone chip fragment formed by the cutting teeth from the groove to better control the advancement of the reamer into the bone, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Scarborough et al. in view of Spranza, III disclose the claimed invention except for the channel extending at an inclined angle from the cutting edge relative to the longitudinal axis of the reamer. It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Scarborough et al. in view of Spranza, III with the channel extending at an inclined angle from the cutting edge relative to the longitudinal axis of the reamer in order to facilitate a more efficient clearing of bone chip fragment formed by the cutting teeth from the groove to better control the advancement of the reamer into the bone, since the applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing an inclined angle. In re Dailey and Eilers, 149 USPQ 47 (1966).

Scarborough et al. in view of Spranza, III disclose the claimed invention except for the channel extending along the reamer from the cutting edge by a distance of 10 mm – 15 mm. It would have been obvious to a person having ordinary skill in that art at

the time of the invention to construct the invention of Scarborough et al. in view of Spranza, III with the channel extending along the reamer from the cutting edge by a distance of 10 mm – 15 mm in order to facilitate a more efficient clearing of bone chip fragment formed by the cutting teeth from the groove to better control the advancement of the reamer into the bone, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

**Claim 9** is rejected under 35 U.S.C. 103(a) as being unpatentable over Scarborough et al. (US Patent 5928238) in view of Spranza, III (US Patent 6884245) further in view of Elias et al. (US Patent 5324300).

Scarborough et al. in view of Spranza, III disclose the claimed invention except for a cylindrical cutter which can inter-fit with the reamer to be rotatable relative to the reamer. Elias et al. teach a cylindrical cutting tool (distal end of 124) which can inter-fit with and be rotated relative to a reamer (120) (Figure 10 and column 7, lines 19-33). It would have been obvious to a person having ordinary skill in that art at the time of the invention to construct the invention of Scarborough et al. in view of Spranza, III with the cylindrical cutting tool which can inter-fit with and be rotated relative to a reamer in view of Elias et al. in order to more precisely cut the tissue surrounding the groove once the reamer has cut the majority of the tissue and allow the guard to be left in place in the event the reamer needs removed prior to ending the operation.

### ***Response to Arguments***

In regards to the applicant's arguments with respect to the prior art used in the rejection mailed 21 July 2009, the examiner notes that these arguments are addressed by a new grounds of rejection as set forth above.

In response to applicant's argument that Scarborough et al. is directed towards cutting and forming dowels, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., forming a narrow groove of predetermined width under very fine tolerances) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry E. Waggle, Jr whose telephone number is 571-270-7110. The examiner can normally be reached on Monday through Thursday, 6:30am to 5pm, EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas C. Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry E Waggle, Jr/  
Examiner, Art Unit 3775

/Thomas C. Barrett/  
Supervisory Patent Examiner, Art  
Unit 3775